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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/465,444	12/16/99	FOUND'S	361331-009RE

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EXAMINER

NOLAN, P

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 03/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/465,444

Applicant(s)

Founds et al.

Examiner

Patrick Nolan

Group Art Unit

1644



☒ Responsive to communication(s) filed on Sep 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 and 11-16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-8 is/are allowed.

☒ Claim(s) 9 and 11-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. This application is a Reissue application of U.S. Patent 5,698,197.
2. Claims 1-9 and 11-16 are pending.
3. Claim 12 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
Applicant has not responded to this rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 11 and 13-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over either Makita et al. (J. Biol. Chem., 1992) or Makita et al. (Science, 1992) both in view Harlow et al. (Antibodies, 1988), all of record for reasons set forth in Paper No. 2.
5. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Makita et al. (J. Biol. Chem, 1992), Makita et al. (Science, 1992) and Harlow et al. (Antibodies, 1988) as applied to claims 1, 2, 4, 5, 7, and 8 above, and further in view of Queen et al. (Proc. Natl. Acad. Sci. USA, 1989), all of record for reasons set forth in Paper No. 2.

Applicant's arguments filed 9-6-00 have been fully considered but are not found persuasive.

Applicant argues the attached declaration demonstrates that when another researcher made monoclonal antibodies to AGE's that the resulting binding affinity was lower than the presently claimed antibodies.

However, the declaration filed in the Parent case has not been received for consideration in the present case. Furthermore at issue in the present case is whether one of skill in the art at the

time the invention was made would have been motivated to use the above mentioned prior art references to make the claimed monoclonal antibodies with a reasonable expectation of success in creating said antibodies with said affinity in view of what was readily understood by those in the monoclonal antibody screening art to be recognized as undue amount of experimentation to combine the references and arrive at applicant's claimed invention.

6. Applicant is notified that claims 1-8 in their present form are free of the prior art.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Friday from 8:30 am to 4:30 pm.

9. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.



Patrick J. Nolan, Ph.D.
Primary Examiner, Group 1640
March 12, 2001